

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner,

v.

TLI COMMUNICATIONS LLC,
Patent Owner.

Case IPR2014-00566
Patent 6,038,295

Before JAMESON LEE, BART A. GERSTENBLITH, and
JO-ANNE M. KOKOSKI, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding
37 C.F.R. § 42.5

Introduction

On June 20, 2014, a conference call was held. The participants of the call were respective counsel for the parties and Judges Lee, Gerstenblith, and Kokoski. Counsel for Patent Owner initiated the call to discuss an issue regarding routine discovery. According to counsel for Patent Owner, for a two-week period from June 2, 2014, through June 16, 2014, when he sought assistance from the Board by way of a request for a conference call, counsel for Petitioner was unavailable to discuss the matter because they were “in trial” for another litigation.

Discussion

Counsel for Petitioner did not dispute that they were unavailable during the two-week period referred to by counsel for Patent Owner. Also, counsel for Petitioner confirmed that they were unavailable because they were “in trial.”

For *inter partes* review proceedings, even preliminary proceedings prior to institution of trial, time is of essence. There is not much time to spare, if any, if an issue arises and a party desires to discuss it with opposing counsel prior to seeking relief from the Board. Counsel’s being unavailable for two weeks is entirely unacceptable, especially when the event causing the “unavailability” is a planned absence. We expect counsel to respond to a discussion request within one business day or two, even if only to schedule the discussion within several more days, if acceptable to the party requesting the discussion. If lead counsel is unavailable, a backup counsel should step forward. If all counsel are unavailable for an extended period, there is a problem. Counsel for both parties are on notice that such conduct is sanctionable under 37 C.F.R. § 42.12(4).

According to counsel for Patent Owner, Petitioner appears not to have satisfied the requirements of routine discovery under 37 C.F.R. § 42.51(b)(1)(iii), which requires production of relevant information that is inconsistent with the

filing of documents and things that contain the inconsistency. Counsel for Patent Owner notes certain deposition testimony of Petitioner's expert, in an earlier litigation involving Petitioner and in which U.S. Patent No. 6,038,295 was applied as prior art, that appears contrary to the declaration testimony of Petitioner's expert in this proceeding regarding the disclosures of U.S. Patent No. 6,038,295.

We directed the parties to engage in a meaningful and serious discussion pertaining to Patent Owner's concern, and suggested that the Patent Owner communicate its basis for thinking that inconsistent information has not been disclosed by Petitioner. We authorize the Petitioner, based on any information provided by Patent Owner, to update its disclosure under the routine discovery requirements of 37 C.F.R. § 42.51(b)(1)(iii).

Order

It is

ORDERED that the parties shall engage in a discussion of Patent Owner's concerns regarding whether Petitioner has complied with the routine discovery requirements of 37 C.F.R. § 42.51(b)(1); and

FURTHER ORDERED that by June 27, 2014, Petitioner shall make any additional disclosure, as necessary, to come in compliance with 37 C.F.R. § 42.51(b)(1), and also file a statement by that date affirming that it is in compliance with the requirements of 37 C.F.R. § 42.51(b)(1).

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